

## **REMARKS**

Original claim 1 and new claims 62-77 are pending upon entry of the above-made amendments. Claims 2-61 are canceled, without prejudice.

The specification has been amended at page 1, line 3, by the addition of a new paragraph disclosing that the present application is a continuation of application Serial No. 09/090,754 ("the '754 application"), filed June 4, 1998, which, in turn, is a continuation of application Serial No. 08/527,391 ("the '391 application"), filed September 13, 1995 (issued November 17, 1998, as U.S. Patent No. 5,837,251).

The specification has also been amended, in part, to correct minor typographical or editorial errors. No new matter has been introduced.

Specifically, "VYDAC" at page 31 has been properly identified as a trademark and its source has been indicated, Separations Group, Inc. inherently being the owner of such registered trademark and, thus, the source of the product.

Support for the amendment at page 37, lines 8 and 18, with respect to mixed lymphocyte tumor cell assay, can be found, for example at page 55, line 16.

Support for the amendments, at pages 14 and 60, to the references to Figures 5A and 5B, which were inadvertently reversed, can be found, for example in the figures themselves. In particular, Figure 5A contains a reference to ATP in the text above the graph, and Figure 5B contains a reference to ADP in the text above the graph. Moreover, it would be readily apparent to one of ordinary skill in the art the graph in Figure 5B indicates the association of peptides with heat shock protein 70 (ADP-bound and ADP eluted), whereas Figure 5A indicates, in comparison, a lack of association of peptides with heat shock protein 70 (ATP-bound and ATP eluted).

Support for the amendments at pages 53 and 54 regarding UV6139SJ cells can be found, for example, in at page 13, line 3; and page 54, lines 4 and 5.

The specification has been amended at page 16, line 25 to replace material incorporated by reference with actual text referred to, in accordance M.P.E.P 2163.07(b) and 608.01(p). No new matter has been introduced. More specifically, Gething, et al., 1992 *Nature* 355:33-45 (a copy of which is attached hereto as Exhibit A); and Lindquist, et al., 1988, *Annu. Rev. Genetics* 22:631-677 (a copy of which is attached hereto as Exhibit B) were each incorporated by reference at page 16, lines 19-21 of the specification with respect to the preceding description, at page 16, lines 6-16, of the members of hsp60, hsp70, and hsp90

families of proteins. Accordingly, the actual text of Table 1 at page 35 of Gething et al., which describes various family members of each of these protein families, has been included in the specification. In addition, the actual text of the first two sentences below the heading "*Saccharomyces cerevisiae*" at page 642, lines 5-10 of Lindquist et al., which describes the genes encoding the members of the hsp70 protein family in *Saccharomyces cerevisiae*, has been included in the specification.

Applicant submits herewith a Declaration under 37 C.F.R. § 1.68 and M.P.E.P. 608.01(p) which states that the amendatory material that was included in the specification at page 16, line 25 consists of the same material incorporated by reference in the application as filed at page 16, lines 19-21.

The name of the table at page 20, line 21 of the specification as filed has been changed from Table 1 to Table 2 to reflect the inclusion of the actual text of Table 1 from Gething et al. at page 16, line 25, as set forth above.

The specification has been amended at page 36, line 31, and at page 60, line 22, to recite an inherent property of the complex produced by the methods described at page 36, lines 25-32, and at page 60, lines 4-23, respectively, in accordance with M.P.E.P. 2163.07(a). *See In re Reynolds*, 443, F.2d 384, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 480 F.2d 1376, 178 USPQ 279 (CCPA 1973). More specifically, the methods described at page 36, lines 25-32 inherently produce ADP-hsp-antigenic molecule complexes, and those methods disclosed at page 60, lines 5-25 inherently produce ADP-hsp70-peptide complexes. Thus, no new matter has been introduced.

Claims 1, and 62-77 are currently pending, new claims 62-77 having been added in the present amendment. New claims 62-77 are completely supported in the specification, and no new matter has been introduced.

More specifically, with respect to new claim 62, support for: "a purified ADP-heat shock protein 90-peptide complex" is found at page 16 lines 5-24, at page 36 lines 25-32, including text inserted by the instant Preliminary Amendment, at page 60, lines 5-25, including text inserted by the instant Preliminary Amendment; support for the term "purified" is found in the specification at page 23 lines 8-18 at page 25 line 20 to page 29 line 14, at page 36 lines 5-11, at page 36 lines 18-21, and at page 37 lines 2-5.

With respect to new claim 63, support for "wherein said heat shock protein 90 is selected from the group consisting of hsp90, and grp94 is found in the specification at page

15, lines 29-31 and page 16 lines 5-24 (for hsp90 and gp96) and at page 16 lines 5-24, including the text and Table 1 inserted by the instant Preliminary Amendment (for grp94).

With respect to new claim 64, support for the phrase “wherein said ADP-heat shock protein 90-peptide complex comprises a heat shock protein 90-peptide complex made *in vitro*,” is found in the specification at page 23, lines 5-15 and page 35 line 24 to page 37 line 12 of the present specification.

With respect to new claim 65, support for the phrase “wherein said heat shock protein 90-peptide complex comprises a heat shock protein 90 and a peptide from the same individual,” is found in the specification at page 10 lines, 7-11.

With respect to new claim 66, support for the phrase “wherein said heat shock protein 90-peptide complex comprises a heat shock protein 90 from a first individual and a peptide from a second, different individual,” is found in the specification at page 10, lines 7-11.

With respect to new claim 67, support for the phrase “wherein said heat shock protein 90-peptide complex comprises a heat shock protein 90 from a first organism and a peptide from a second, different organism,” is found in the specification at page 23, lines 8-18, at page 33, lines 5-9, and at page 34 line 28 to page 35, line 22.

With respect to new claim 68, support for the phrase “wherein said heat shock protein 90-peptide complex comprises a heat shock protein 90 from a first species and a peptide from a second, different species,” is found at page 23, lines 8-18, at page 33, lines 5-9, and at page 34, line 28 to page 35, line 22.

With respect to new claim 69, support for the phrase “in substantially purified form,” is found at page 23 lines 8-18; page 25 line 20 to page 29 line 14; page 36 lines 5-11; page 36 lines 18-21; page 37 lines 2-5; and support for “as indicated by apparent homogeneity upon electrophoresis in a polyacrylamide gel” is found at page 30, lines 20-25, page 13, lines 5-6 (and Figure 1A), page 26, lines 14-18, and page 36, lines 12-21, of the specification.

With respect to new claim 70, support for the phrase “a purified ADP-heat shock protein 90-protein complex, is found in the specification at page 14, lines 27-32, at page 16, lines 5-24, at page 36, lines 25-32, including text inserted by the instant Preliminary Amendment, at page 10, lines 16-22, at page 22, line 30 to page 23, line 4, and at page 60, lines 5-25, including text inserted by the instant Preliminary Amendment at page 23, lines

8-18; support for the term “purified” is found in the specification at page 25, line 20 to page 29, line 14, at page 36, lines 5-11, at page 36, lines 18-21, at page 37, lines 2-5.

With respect to new claim 71, support for the phrase “wherein said heat shock protein 90 is selected from the group consisting of hsp90, gp96, and grp94,” is found in the specification at page 15, lines 29-31 and page 16 lines 5-24 (with respect to hsp90 and gp96, and page 16, lines 5-24, including the text and Table 1 inserted by instant Preliminary Amendment (with respect to grp94).

With respect to new claim 72, support for the phrase “wherein said ADP-heat shock protein 90-protein complex comprises a heat shock protein90-protein complex made *in vitro*,” is found in the specification at page 23, lines 5-15, and at page 35, line 24 to page 37 line 12.

With respect to new claim 73, support for the phrase “wherein said heat shock protein 90-protein complex comprises a heat shock protein 90 and a protein,” is found in the specification at page 10, lines 16-22, at page 22, line 30 to page 23, line 4, at page 32, line 8, and at page 36, line 27; while support for the phrase “from the same individual,” is found in the specification at page 10, lines 7-11.

With respect to new claim 74, support for the phrase “wherein said heat shock protein 90-protein complex comprises a heat shock protein 90 from a first individual and a protein,” is found in the specification at page 10, lines 16-22, at page 22, line 30 to page 23, line 4, at page 32, line 8, and at page 36, line 27, while support for the phrase “from a second, different individual,” is found in the specification at page 10, lines 7-11.

With respect to new claim 75, support for the phrase, “wherein said heat shock protein 90-peptide complex comprises a heat shock protein 90 from a first organism and a protein,” is found in the specification at page 10, line 16-22, at page 22 line 30 to page 23, line 4, at page 32, line 8, and at page 36, line 27, while support for the phrase “from a second, different organism,” is found in the specification at page 23, lines 8-18, at page 33, lines 5-9, and at page 34, line 28 to page 35, line 22.

With respect to new claim 76, support for the phrase “wherein said heat shock protein 90-protein complex comprises a heat shock protein 90 from a first species and a protein,” is found in the specification at page 10, lines 16-22, at page 22, line 30 to page 23, line 4, at page 32, line 8, and at page 36, line 27, while support for the phrase “from a second, different species,” is found in the specification at page 23, lines 8-18, at page 33, lines 5-9, and at page 34, line 28 to page 35, line 22.

With respect to new claim 77, support for the phrase “in substantially purified form,” is found in the specification at page 23, lines 8-18, at page 25, line 20 to page 29, line 14, at page 36, lines 5-11, at page 36, lines 18-21, at page 37, lines 2-5; support for the phrase “as indicated by apparent homogeneity upon electrophoresis in a polyacrylamide gel,” is found in the specification at page 30, lines 20-25, and at page 26, lines 14-18, and page 36, lines 12-21, of the specification.

**Notification to the Examiner Pursuant to 37 C.F.R. § 1.607(c)**

Pursuant to 37 C.F.R. § 1.607(c), Applicant hereby notifies the Examiner that new claims 62-77, presented herein, correspond exactly or substantially to claims 1-18 of U.S. Patent No. 6,433,141 to Wallen *et al.* (“the '141 patent”), which issued August 13, 2002, and is entitled “Purified Heat Shock Protein Complexes.”

The instant application, filed on even date herewith, claims the benefit under 35 U.S.C. § 120 of Application Serial No. 09/090,754 (“the '754 application”), filed June 4, 1998, and of Application Serial No. 08/527,391 (“the '391 application”) filed September 13, 1995, which issued November 17, 1998, as U.S. Patent No. 5,837,251 (“the '251 patent”).

Applicant also hereby notifies the Examiner that Applicant’s parent '754 application is involved in Interference No. 104,761. Interference No. 104,761 was initially declared October 12, 2001, between Applicant’s parent '754 application and U.S. Patent No. 6,747,332 to Wallen *et al.*, and then redeclared February 7, 2002, to add U.S. Patent No. 6,066,716 to Wallen *et al.* (“the '716 patent”).

Applicant further notes that the '141 patent issued August 13, 2002, from Application Serial No. 09/534,381 (“the '381 application”) filed March 24, 2000, which is a division of Application Serial No. 08/934,139 (“the '139 application”), filed September 19, 1997, and issued May 23, 2000, as U.S. Patent No. 6,066,716 (“the '716 patent”), which is a division of Application Serial No. 08/712,239 (“the '239 application”), filed September 20, 1996, and issued May 5, 1998, as U.S. Patent No. 5,747,332 (“the '332 patent”). Again, as noted above both the '332 patent and the '716 patent are involved in Interference 104,761 with Applicant’s parent '054 application.

On September 20, 2002, Applicant filed a Miscellaneous Motion (Fordham

Miscellaneous Motion 4 Under 37 C.F.R. § 1.635 (Exhibit D) requesting that the '141 patent of Wallen be added to ongoing Interference No. 104,761. As part of that Miscellaneous Motion, Applicant submitted a set of proposed claims that are essentially the same as those presented in the instant Preliminary Amendment. To date, no decision has been issued by the Board with a respect to that Miscellaneous Motion. Accordingly, Applicant is filing the present amendment before the one-year anniversary of the issuance of the '141 patent of Wallen *et al.* in order to avoid a 35 U.S.C. § 135(b) issue.

**CONCLUSION**

Applicant respectfully requests that the amendments and remarks be entered and made of record in the instant application. An early allowance is earnestly requested.

Date August 12, 2003

Respectfully submitted,

*Samuel B. Abrams Reg No 30605*

By: *Michael J. Ryan Reg No 41283* 30,605  
Samuel B. Abrams (Reg. No.)

PENNIE & EDMONDS LLP  
1155 Avenue of the Americas  
New York, New York 10036-2711  
(212) 790-9090

Enclosures